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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,304	08/29/2001	Albert S. Deutsch	PISCES 00.01 DIV	8148

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Norman P. Soloway
Hayes, Soloway, Hennessey,
Grossman & Hages, P.C.
130 W. Cushing Street
Tucson, AZ 85701

EXAMINER

FUNK, STEPHEN R

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,304

Applicant(s)

DEUTSCH ET AL.

Examiner

Stephen R Funk

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claims 26 - 28 and 30 are objected to because of the following informalities:

In claim 26 last line "coatings" should be singular as only one coating has been previously recited.

In each of claims 27 and 30 the scope of the preamble is inconsistent with the scope of the preamble of the parent claim. Note the lack of the term "lithographic" in claims 27 and 30. A dependent claim may not claim less than a parent claim.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 - 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ma et al. ('653) in view of Bratt ('528). Ma et al. teach a printing plate having a substrate with a coating which has been imparted with insolubility with an alkaline material. See column 6 lines 16 - 26, column 7 lines 15 - 43, and claims 9, 10, and 21 of Ma et al., for example. Ma et al. refers to Bratt for suitable substrates in column 6 lines 24 - 26. In column 5 lines 23 - 44 Bratt disclose the conventionality of an anodized aluminum substrate. It would have been obvious to one of ordinary skill in the art to provide the plate of Ma et al. with an aluminum substrate in view of Bratt so as to provide an economical dimensionally stable substrate. With respect to claim 28 it would have been obvious to one of ordinary skill in the art through routine experimentation to provide the coating with a thickness from 1 to 3 microns.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29 - 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 11 of U.S. Patent No. 6,315,916 in view of Ma et al. and Bratt. Patented claims 1 - 11 recite a printing plate having a diazo coating (claim 1 lines 1 - 2) wherein an image is insoluble in a developer due to a higher concentration of alkaline material (claim 1 line 3, claim 2 or 7, claim 6 line 3). The patented claims do not recite an anodized aluminum plate. Ma et al. teaches a similar plate and refers to Bratt for suitable substrates, who teaches the conventionality of an anodized aluminum substrate. Note the comments above with respect to Ma et al. and Bratt. It would have been obvious to one of ordinary skill in the art to provide the plate in the patented claims with an anodized aluminum substrate in view of Ma et al. and Bratt to provide a well known, dimensionally stable, hydrophilic substrate. With respect to claim 31 the recited thickness would have been obvious to one of ordinary skill in the art through routine experimentation lacking any evidence of criticality.

Claims 29 - 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 7 of U.S. Patent No. 6,523,471 in view of Ma et al. and Bratt. Patented claims 1 - 7 recite a printing plate having a diazo coating (claim 1 lines 6 - 7, claim 7 lines 6 - 7) wherein an image is insoluble in a developer due to a higher concentration of alkaline material (claim 1 lines 6 - 8, claim 7 lines 2 and 7 - 8). The patented claims do not recite an anodized aluminum plate. Ma et al. teaches a similar plate and refers to Bratt for suitable substrates, who teaches the conventionality of an anodized aluminum substrate. Note the comments above with respect to Ma et al. and Bratt. It would have been obvious to one of ordinary skill in the art to provide the plate in the patented claims with an anodized aluminum substrate in view of Ma et al. and Bratt to provide a well known, dimensionally stable, hydrophilic substrate. With respect to claim 31 the recited thickness would have been obvious to one of ordinary skill in the art through routine experimentation lacking any evidence of criticality.

Applicant's arguments filed June 9, 2003 have been fully considered but they are not persuasive with respect to claim 26. Ma et al. disclose that the esterification agent itself is the alkaline material in column 7 lines 39 - 43. The aluminum substrate is taught by Bratt. Claims 29 and 31 would be allowable upon receipt of properly filed terminal disclaimers. Claim 30 would be allowable upon receipt of the properly filed terminal disclaimers and if rewritten or amended to overcome the objection(s) set forth in this Office action.

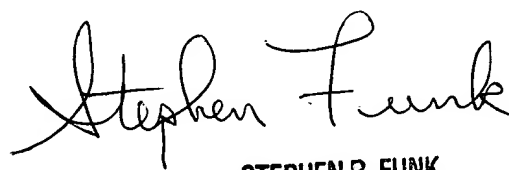
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk at telephone number (703) 308-0982. The examiner can normally be reached Monday - Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (703) 305-6619.

The fax number for *official* papers is (703) 308-7722, 7724. The fax number for those wishing an auto-reply verifying receipt of *official* papers is (703) 872-9318 or for After-Final actions is (703) 872-9319. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0956.

Stephen Funk
July 10, 2003



STEPHEN R. FUNK
PRIMARY EXAMINER